

Docket No. 87344.1524
Application No. 10/621,317
Customer No. 30734

Patent

Amendments to the Drawings:

In light of this amendment, Applicants respectfully requests that the amendment to drawings being entered and the objection to the drawings be removed.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

The Office Action dated October 14, 2004 has been received and its contents carefully considered. Claims 1-6 are pending. Claims 1-6 have been rejected. Claims 1, 4, 5 and 6 have been amended.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

OFFER TO SURRENDER AND RETURN ORIGINAL PATENT

A Statement addressing the loss or inaccessibility of the original patent is submitted herewith in accordance with 37 C.F.R. §1.178.

REISSUE OATH/DECLARATION

The Examiner stated that the Reissue Oath/Declaration filed with the application was defective. A new oath is submitted herewith and is believed to be in compliance with 37 C.F.R. §1.63(a)(2). Claims 1-6 were rejected as being based upon a defective reissue Declaration under 35 U.S.C. §251. Withdrawal of the rejection is respectfully requested in view of the newly submitted Oath/Declaration.

SPECIFICATION

Changes to the Specification were made beginning at column 4, line 11 and beginning at column 4, line 37 of U.S. Patent No. 5,443,722. No new matter has been added.

DRAWINGS

Revisions to the drawings have been submitted in order to correct informalities. No new matter has been added. Specifically, in FIG. 2, item 112 has been replaced with item 103 which describes an O- ring. A similar change is reflected in FIGS. 3 and 4. In addition, element 74 has been deleted in FIG. 3.

The drawings were objected to by the Examiner in the previous Office Action. Accordingly, element 74 has been deleted in FIG. 3. Elements 28, 112 and 116 have been addressed in amendments to the specification. It is believed that the drawings are in compliance.

The drawings were objected under 37 C.F.R. §1.83(a) for failing to show the limitation of the valve control including the second strainer chamber as cited by the Examiner. The aforementioned claim recitation has been amended in claim 5. It is believed that the drawings are in compliance.

CLAIM REJECTIONS – 35 U.S.C. § 112, first paragraph

Claim 5 was rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Without conceding the propriety of the rejection, independent claim 5 has been amended. It is believed that claim 5 is in compliance.

CLAIM REJECTIONS – 35 U.S.C. § 112, second paragraph

Claims 1-6 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated with respect to claims 1 and 4-6 that it was unclear as to how the first and second chambers were formed since no structure for the front of the chambers was

recited in those claims. Without conceding the propriety of the rejection, independent claims 1 and 4 have been amended to include a first chamber and a second chamber. Claim 6 already recited a first strainer chamber in a second strainer chamber. It is believed that claims 1 and 4-6 are in compliance.

The Examiner stated that claim 5 lacks proper antecedent for “said third and fourth port.” Additionally, the Examiner stated that “said coupling means” lacked proper antecedent basis. Claim 5 has been amended accordingly. In addition, the claim language has been amended to clarify how the first and second three way valves relate to the valve control. It is believed that claim 5 is in compliance.

CLAIM REJECTIONS – 35 U.S.C. § 102(b)

Claims 1 and 2 were rejected under 35 U.S.C. §102 as being anticipated by *Oliver*. It is believed that the Examiner meant to reject claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by *Oliver, et al.* (U.S. Patent No. 3,900,401) (also reflected in the NOTICE OF REFERENCES CITED (PTO-892)). No additional reference to *Oliver* was provided and the references to item numbers provided in the 35 U.S.C. §102(b) rejection by the Examiner correspond to the elements of *Oliver, et al.* (U.S. Patent No. 3,900,401).

Without conceding the propriety of the rejection, independent claim 1 has been amended. It is respectfully submitted that *Oliver, et al.* does not teach, *inter alia*, a duplex strainer for straining a fluid comprising a “coupling causing said first three-way ball valve and said second three-way ball valve to move in unison, causing fluid to flow either entirely through said first strainer chamber, entirely through said second strainer chamber, or through both said first strainer chamber and said second strainer chamber simultaneously” as recited in claim 1.

Oliver, et al. discloses a dual lubricating oil filter having a double-ball valve for selectively directing the flow of oil through one of a pair of filter elements (see Abstract). The structure of the dual lubricating oil filter of *Oliver, et al.* teaches away from the invention, as recited in claim 1, because it is not capable of causing fluid to flow through both the first strainer chamber and second strainer chamber simultaneously. *Oliver, et al.* discloses that oil can flow to either one section or to the other. In fact, the design of *Oliver, et al.* deliberately prevents any shifting of the flow of oil to a section which is not pressurized (e.g., see column 1, lines 41-51, column 2, lines 45-48, column 3, lines 33-54, column 3, line 66 through column 4, line 3). Thus, the dual lubricating oil filter of *Oliver, et al.* is specifically designed to prevent flow into more than one filter section at a time and, hence, cannot be said to allow fluid to flow through a first strainer chamber and a second strainer chamber simultaneously as recited in claim 1.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, *Oliver, et al.* cannot be said to anticipate the invention as recited in claim 1. Hence, withdrawal of the rejection is respectfully requested.

Claim 2 depends from independent claim 1 and is patentable over the cited prior art for at least the same reasons as is claim 1.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 1, 2 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Oliver, et al.* in view of *Rea, et al.* Without conceding the propriety of the rejection independent claims 1 and 4 have been amended. It is respectfully submitted that *Oliver, et al.* does not teach, *inter alia*, a duplex strainer for straining a fluid comprising a “coupling causing said first three-

way ball valve and said second three-way ball valve to move in unison, causing fluid to flow either entirely through said first strainer chamber, entirely through said second strainer chamber, or through said first strainer chamber and said second strainer chamber simultaneously” as recited in claim 1 and similarly in claim 4. As outlined above, *Oliver, et al.* fails to teach simultaneous fluid flow through a first strainer chamber and a second strainer chamber as recited in claim 1 and similarly in claim 4. The aforementioned was further conceded by the Examiner in the previous Office Action.

In addition, *Oliver, et al.* fails to at least teach the structure recited in claim 1 and similarly in claim 4 which includes a first strainer chamber for straining fluid having first and second ports in separate fluid communication with the housing and a second strainer chamber for straining fluid having a third port opposing the first port and a fourth port which opposes the second port in separate fluid communication with the housing. The Examiner purports that *Oliver, et al.* discloses a first strainer chamber 12 having first and second ports each in separate fluid communication with the housing along with a second strainer 13 having a third port facing the first port and fourth port facing the second port, each in separate communication with the housing. However, upon further review of *Oliver, et al.*, it fails to disclose in the figures or in the description, a first and second port with a third port opposing the first port and a fourth port opposing the second port. The Examiner merely asserts that the first, second, third and fourth ports exist (as recited in claims 1 and 4) without providing any additional support such as pointing to specific structure allegedly taught by *Oliver, et al.* For instance, no specific port passage ways are shown in any of the figures of *Oliver, et al.* nor are they described in the specification of *Oliver, et al.* as recited in claims 1 and 4.

Furthermore, *Oliver, et al.* lacks a teaching of “said coupling including a first notch formed within said first three-way valve, and a second notch formed within said second three-way valve, and a shaft, said shaft including a first flange and a second flange, said first flange being received within said first notch and said second flange being received within said second notch” as recited in claim 4.

Rea, et al. does not cure the deficiencies of *Oliver, et al.*, because it, too, fails to teach the first and second ports in separate fluid communication with the housing and a third port opposing the first port and a fourth port opposing the second port in separate fluid communication with the housing as recited in claims 1 and 4.

In addition, *Rea, et al.* fails to teach “said coupling including a first notch formed within said first three-way valve, and a second notch formed within said second three-way valve, and a shaft, said shaft including a first flange and a second flange, said first flange being received within said first notch and said second flange being received within said second notch” as recited in claim 4.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Therefore, since the prior art lacks all the claimed features, *Oliver, et al.* alone or in combination with *Rea, et al.*, cannot be said to teach or suggest the invention as recited in claims 1 and 4. Hence, withdrawal of the rejection is respectfully requested.

The Examiner also turns to *Rea, et al.* to disclose a ball valve to allegedly permit simultaneous flow through both strainer chambers such as those used by *Oliver, et al.* However, it is clear that *Oliver, et al.* teaches away from simultaneous flow, because the dual lubricating oil filter is specifically designed to only allow the flow of oil to one section at a time. The structure of *Oliver, et al.* including, for instance, the slide bar 39, vent valve 42, vent valve 43, and slide bar 37 cammed to a timing disk 41 which is rotated with hand wheel 22 is specifically designed to provide a limited fluid flow by selectively passing through one of two filters in order to address safety features and prevent flow to a filter that has an open cover (see column 3, lines 64 through column 4, line 3). In accordance with the M.P.E.P. §2142, to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Since the dual lubricating dual oil filter of *Oliver, et al.* is deliberately designed to prevent simultaneous fluid flow to both filter sections 12 and 13 (*i.e.*, including specific design mechanisms to only allow fluid flow to one filter section 12 or 13 at a time), there can be no motivation to suggest modifying the components of *Oliver, et al.* in order to allow simultaneous fluid flow in accordance with the M.P.E.P.

Furthermore, in accordance with the M.P.E.P., the teaching or suggestion to make the claim combination and reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). Thus, it is not clear how a reasonable expectation of success could be met by modifying *Oliver, et al.* with *Rea, et al.*, as proposed by the Examiner, when *Oliver, et al.* specifically teaches away from performing a simultaneous fluid flow while *Rea, et al.* discloses performing a simultaneous fluid flow operation. The particulars of *Oliver, et al.* are in direct opposition to the

particulars of *Rea, et al.*; thus, it is respectfully submitted that one of ordinary skill in the art would not turn to *Rea, et al.* to modify *Oliver, et al.*

Claim 2 depends from independent claim 1 and is patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 3, 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Oliver, et al.* in view of *Rea, et al.* and *Elliott*. Claim 3 depends from independent claim 1. *Oliver, et al.* in view of *Rea, et al.* fails to teach the invention as recited in claim 1 as outlined above. *Elliott* fails to remedy the deficiencies of *Oliver, et al.* in view of *Rea, et al.*, because it, too, does not teach a coupling causing a first three way ball valve and second three way ball valve to move in unison, causing fluid to flow either entirely through the first strainer chamber, entirely through the second strainer chamber, or through both the first strainer chamber and the second strainer chamber simultaneously as recited in claim 1. The aforementioned features are similarly recited in claims 5 and 6.

In addition, claims 3, 5 and 6 recite a first strainer chamber having first and second ports and a second strainer chamber having a third port opposing the first port and a fourth port opposing the second port. Claims 3, 5 and 6 further recite that the first strainer chamber is unitarily formed with the housing whereas the second strainer chamber is detachably mounted to the housing. *Oliver, et al.* fails to teach at least the aforementioned structure of the first and second ports in a first strainer chamber and the third and fourth port in the second strainer as recited in claims 3, 5 and 6. *Rea, et al.* and/or *Elliott*, taken singularly or in combination, fail to remedy the deficiencies of *Oliver, et al.*, because they, too, do not teach the structure and/or the relationship of the first, second, third and fourth ports with respect to one another as recited in claims 3, 5 and 6. Therefore, since the prior art lacks all the claimed features, *Oliver, et al.*,

alone or in combination with *Rea, et al.* and *Elliott*, cannot be said to teach or suggest the invention as recited in claims 3, 5 and 6. Hence, withdrawal of the rejection is respectfully requested.

In addition, claim 5 recites structure for a coupling means including a first notch formed within the first three-way valve and a second notch formed within a second three-way valve. Claim 5 further recites a shaft including a first flange and a second flange, wherein the first flange is received within the first notch and the second flange is received in the second notch. Additionally, claim 5 further recites that the shaft extends through the divider.

Oliver, et al. fails to teach at least the aforementioned structure of the coupling means including the first and second notch and the shaft including the first and second flange in combination with the shaft extending through the divider. *Rea, et al.* and/or *Elliott*, taken singularly or in combination, fail to remedy the deficiencies of *Oliver, et al.*, because they, too, do not teach the structure and/or the relationship of the coupling means (including the first and second notch), the shaft (including the first and second flange), and the shaft extending through the divider as recited in claim 5. Therefore, since the prior art lacks all the claimed features, *Oliver, et al.*, alone or in combination with *Rea, et al.* and *Elliott*, cannot be said to teach or suggest the invention as recited in claim 5. Hence, withdrawal of the rejection is respectfully requested.

Claims 3 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Oliver, et al.* in view of *Elliott*. *Oliver, et al.* fails to teach the invention as recited in claims 3 and 6 as outlined above. *Elliott* fails to remedy the deficiencies of *Oliver, et al.*, because it, too, does not teach a coupling causing a first three way ball valve and a second three way ball valve to move in unison, causing fluid flow to flow either entirely through the first strainer chamber, entirely

through the second strainer chamber or through both the first strainer chamber and the second strainer chamber simultaneously.

In addition, claims 3 and 6 recite a first strainer chamber having first and second ports and a second strainer chamber having a third port opposing the first port and a fourth port opposing the second port. Claims 3 and 6 further recite that the first strainer chamber is unitarily formed with the housing and the second strainer chamber is detachably mounted to the housing. *Oliver, et al.* fails to teach the aforementioned structure of the first and second ports in a first strainer chamber and the third and fourth port in the second strainer as recited in claims 3 and 6. *Elliott* fails to remedy the deficiencies of *Oliver, et al.* because it, too, does not teach the structure and/or the relationship of the first, second, third, and fourth ports with respect to one another as recited in claims 3 and 6. Therefore, since the prior art at least lacks the claimed features discussed above, *Oliver, et al.*, alone or in combination with *Elliott*, cannot be said to teach or suggest the invention as recited in claims 3 and 6. Hence, withdrawal of the rejection is respectfully requested.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', is written over a horizontal line.

Marc W. Butler
Reg. No. 50,219

Date: February 14, 2005
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1500
Facsimile: 202-861-1783